

Remarks

This amendment is being filed with the Rule 114 request for continued examination of application Serial no. 10/652,670.

In an Office Action dated June 6, 2006, the specification was objected to under 37 C.F.R. §1.75(d)(1). Further, claims 22 and 33-58 were rejected under 35 U.S.C. §112, claims 45 and 58 were rejected under 35 U.S.C. §101, and claims 22 and 33-58 were rejected under 35 U.S.C. §103. In this amendment, claims 22 and 33-58 have been canceled, and new claims 59-81 are presented.

In an effort to advance the prosecution of this case, the previous claims have been canceled, and new claims have been drafted in an attempt to eliminate some of the language objected to by the Examiner pursuant to the 35 U.S.C. §§101 and 112. Notably, the new claims in the present application are believed to comply with §§101 and 112 to at least the same extent as claim 1 in related application Serial No. 11/278,688. Claim 1 in related application Serial No. 11/278,688, which uses terminology similar to the claims in the present application, was recently allowed by Examiner Botts. See Serial No. 11/278,688 (Notice of Allowance dated 9/12/2006).

The objection to the specification as failing to provide proper antecedent basis for the term “display element” used in the previous claims is respectfully traversed. Even if the term “display element” is not found within the text of the specification, there is clear support in the description so that the meaning of this phrase may be readily ascertained from the specification without confusion. See MPEP 608.01(o) (“The meaning of every term . . . should be apparent from the descriptive portion of the specification with clear disclosure as to its import . . .”); See 37 C.F.R. 1.75(d)(1) (requiring “clear support or antecedent basis . . . so that the meaning . . . may be ascertainable . . .”) (emphasis added).

Note that the term “display element” is not in the claims currently pending in this application.

The claim rejections under 35 U.S.C. §112 for failing to comply with the written description requirement are also respectfully traversed. All of the limitations listed in paragraph 6 of the Office Action dated June 6, 2006 are disclosed in the specification in the manner required by 35 U.S.C. §112. Note, by way of example, the support provided

by Figures 12a through 12f and the text accompanying those figures. Also note that the terms “first document,” “first author,” and similar terms are simply used as labels in the claims to distinguish between different documents and authors.

The newly presented claims are allowable over the art relied-upon by the Examiner, U.S. Patent No. 5,444,615 (the “Bennett reference”) and the user manual for “CheckCite 4.0 for Windows” (the “CheckCite reference”). Claim 59 is directed to a system for providing information, and requires the operation of:

displaying the first document in the document viewing program executing at the client computer, where displayed within the document viewing program are (a) the first content portion, (b) a representation of the second document, (c) the second content portion, and (d) a representation of the third document,

where the representation of the second document is automatically displayed within the document viewing program . . . [and]

where the first document is displayed so that the representation of the second document can be selected by the user with an input device associated with the client computer while the first content portion is within the document viewing program . . .

Claim 69 is directed to a similar method of providing information, and that claim requires the acts of:

responding to the request for the first document by transferring the first document over the network to the client computer operated by the user, and including within the first document (a) the first content portion, (b) a representation of the second document, (c) the second content portion, and (d) a representation of the third document,

where the representation of the second document is automatically included within the first document . . . ; and

enabling the display of the first document . . . , where the first document is displayed so that the representation of the second document can be selected by the user while the first document is within the document viewing program . . .

These limitations of claims 59 and 69, when combined with the other limitations in those claims, are not taught by the Bennett reference or CheckCite reference, and therefore, these claims are allowable over those references.

Claim 74 is directed to a system for, and claim 79 is directed to a method of providing information on a network. Claim 74 requires carrying out the operations of:

responding to the request for the first web page by transferring the first web page over the network to the client computer operated by the user, and including within the first web page the first content portion created by the first author and a representation of the third web page,

where the representation of the third web page is automatically included within the first web page . . . ; and

enabling the display of the first web page . . . , [and] enabling the user to select the representation of the third web page while the first content portion is within in the web browser window.

These limitations of claim 74, when combined with the other limitations in that claims, are not taught by the Bennett reference or CheckCite reference, and therefore, claim 74 is allowable over those references.

Similarly, claim 79 is a method claim requiring the acts of:

responding to the request for the first web page by transferring the first web page over the network to the client computer requesting the first web page, and including within the first web page the first content portion created by the first author and a representation of the third web page,

where the representation of the third web page is automatically included within the first web page . . . ; [and]

enabling the display of the first web page . . . , [and] enabling selection of the representation of the third web page from within the first web page

These limitations of claim 79, when combined with the other limitations in that claims, are not taught by the Bennett reference or CheckCite reference. Accordingly, claim 79 is also allowable over the Bennett and CheckCite references.

Claims canceled in this amendment are canceled without prejudice to the subject matter claimed therein. There may be other distinctions between the inventions claimed in this application and the art relied upon by the Examiner, but it is believed that the foregoing is sufficient to demonstrate that the pending claims are allowable over the relied-upon art.

This application should now be in condition for allowance. Should the Examiner feel that a conversation with the Applicant will expedite the examination of this application, the Examiner is encouraged to telephone the undersigned at the number listed below.

Respectfully submitted,

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